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MAY 24 1945

CHARLES E. BROWN, CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1945.

No. **1309** 88

**MADGE MESSLER,**

*Petitioner,*

v.

**UNITED STATES RUBBER COMPANY,**

*Respondent.*

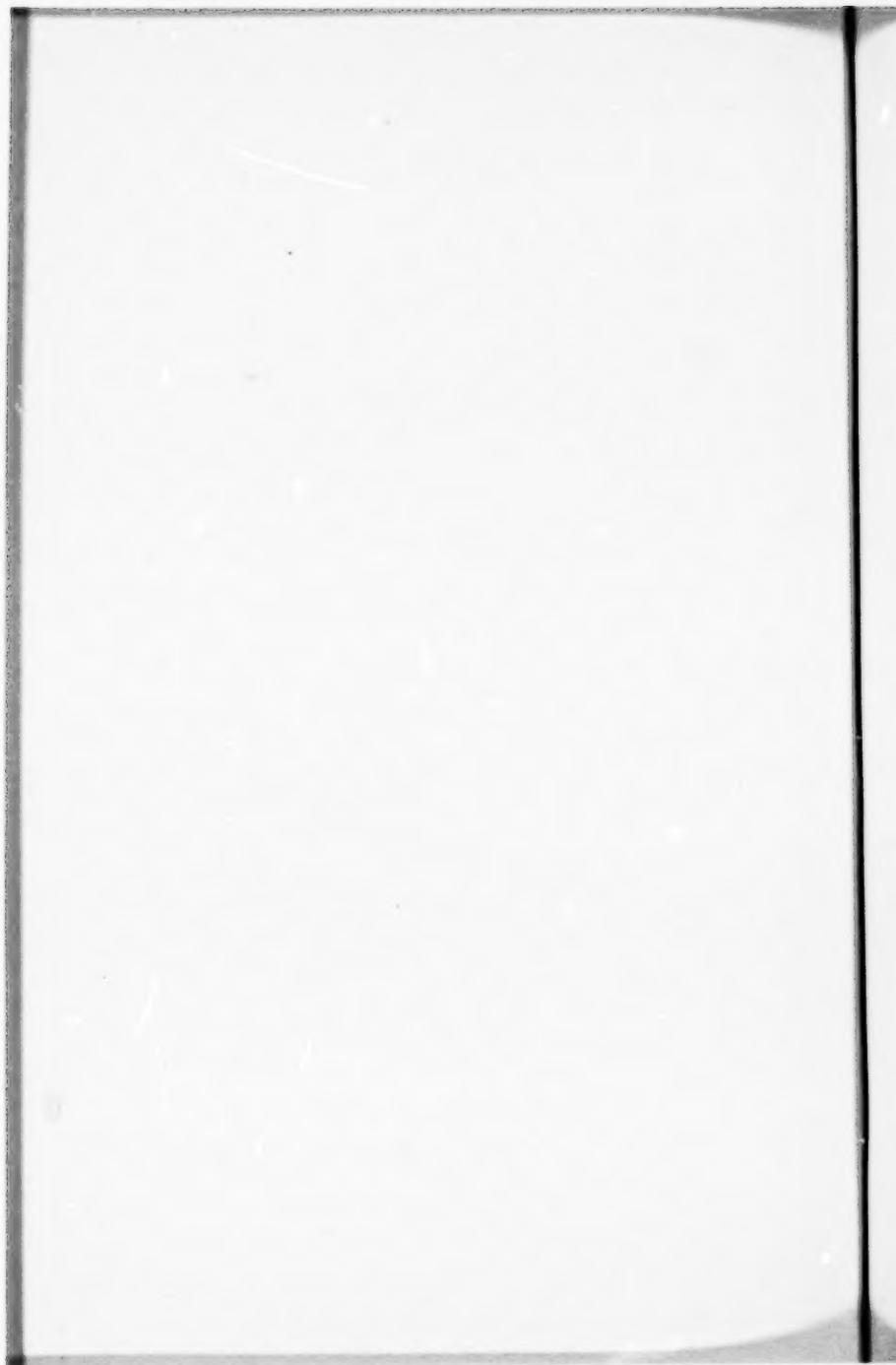
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**PETITION FOR WRIT OF CERTIORARI AND  
BRIEF SUPPORTING SAME.**

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**NATHANIEL FRUCHT,**

*Attorney for Petitioner.*



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OCTOBER TERM, 1945.

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MADGE MESSLER,

Petitioner,

v.

} No.  
} Respondent.

UNITED STATES RUBBER COMPANY,

---

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT.**

To the Honorable The Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Madge Messler, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit to review the judgment of that Court entered May 10, 1945.

**Short Statement of the Case.**

The plaintiff, Madge Messler, is the owner of United States Reissue Patent No. 18,237, granted October 27, 1931, for a Cushioning Insole for Boots and Shoes, duly assigned to the plaintiff by Matie C. Messler, the inventor. The defendant, United States Rubber Company, is a manufacturer of articles made wholly or partly of rubber, and has manufactured and sold shoes which plaintiff contends are infringements of the Messler patent.

Civil action No. 179 having been brought in the District Court of the United States for the District of Connecticut, and having been duly heard, decision was rendered March 3, 1944, for the defendant. The plaintiff appealed to the Circuit Court of Appeals for the Second Circuit, and the appeal having been duly heard, the decision of the District Court was affirmed May 10, 1945.

### **Jurisdiction.**

This Court has jurisdiction to review the judgment in question under 240-A of the Judicial Code (28 U. S. Code, Sec. 347).

### **The Grounds for Review.**

1. The decision held the reissue patent in suit invalid over United States Patent No. 1,697,589 to Cort, which patent discloses the invention but does not claim it; this reference was before the United States Patent Office, and was duly overcome by an affidavit under Rule 75 of the Patent Office Rules of Practice. No evidence controverting or attacking the affidavit was presented by the defendant. The Court of Appeals held:

“The contention that the self-serving declarations of the affidavit filed in the Patent Office five years after Cort’s application should be given weight as evidence or should shift the burden of proof to the defendant is to say the least, surprising.”

The first ground for review is, that the holding that an affidavit under Rule 75 should not be given weight as evidence and should not shift the burden of proof to the defendant is contrary to the pronouncements of the United States Supreme Court in analogous cases.

2. The decision held that a cited patent which was overcome by an affidavit under Rule 75 was a valid reference.

The second ground for review is, that this decision is contrary to the holdings in similar cases in the Court of Appeals for the Ninth Circuit and the Fourth Circuit.

3. The decision held that the issue of a patent as the result of an affidavit under Rule 75 in no sense was the equivalent of an adjudication of priority.

The third ground for review is, that the holding that an issue of a patent pursuant to filing and acceptance of an affidavit under Rule 75 is in no sense an equivalent of an adjudication of priority, is contrary to the intent of the Revised Statutes, Sec. 483.

4. The decision held that the issue of a patent as the result of an affidavit under Rule 75 does not involve any exercise of discretion by the Patent Office, and results from the mere filing of the affidavit.

The fourth ground for review is, that the issue of a patent under the circumstances stated, does involve the exercise of discretion and judgment by the Patent Office, and is not the result of merely filing the affidavit.

5. The decision held that in a suit which hinges on an affidavit under Rule 75, the allegedly infringing defendant is not required to controvert the truth of the affidavit.

The fifth ground for review is, that an affidavit under Rule 75 which is vital to a case, requires a defendant to controvert the truth of the affidavit.

6. The decision, with respect to the issue of infringement, narrowly construed the claims without considering the substance of the invention and confined the invention to the specific construction described.

The sixth ground for review is, therefore, that the decision is not in accord with rulings of the United States Supreme Court holding infringement where the substance of an invention has been appropriated.

**Prayer.**

WHEREFORE, your petitioner respectfully prays that the petition be granted.

MADGE MESSLER,  
By NATHANIEL FRUCHT,  
Attorney for Petitioner.





**BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.****Opinions of the Courts Below.**

The opinion of the District Court is found on page 79a of the Record. The opinion of the Court of Appeals of the Second Circuit is included in the record sent to this Court, at the end thereof.

**Jurisdiction.**

The jurisdiction as to review is stated in the foregoing Petition.

**Statement of Case.**

The material facts necessary to an understanding of the reasons relied upon for granting the writ are contained in the foregoing Petition.

**ARGUMENT.****POINT 1.****An affidavit under Rule 75 shifts the burden of proof.**

The practice under Rule 75 is well established in the Patent Office and has received the sanction of the courts. *Deering v. Winona Harvester Works*, 155 U. S. 286; *Pullman's Palace Car Co. v. Boston, etc., R. R.*, 44 F. 195.

In the *Deering* case, Justice Brown stated as to the proof introduced by the plaintiff to antedate a foreign

patent that "his oath was accepted by the Patent Office as decisive of the fact."

The reasonable presumption of validity furnished by the grant of a patent on the basis of an affidavit under Rule 75 is not destroyed except by convincing evidence, and the burden of proof should remain on the defendant. *Corona Co. v. Dovan Corp.*, 276 U. S. 358.

Justice Bradley, in *Miller v. Brass Co.*, 104 U. S. 350, held that when a patent does not claim an invention, it is either not the patentee's invention, or, if his, he dedicates it to the public. Note *Alvord v. Smith, et al.*, 216 F. 150 at 160.

It is submitted that the burden of proof, when the validity of a patent is attacked on the basis of a reference overcome by an affidavit under Rule 75, rests on the defendant, and not on the plaintiff.

## POINT 2.

### **An antedated prior patent is not a valid reference.**

The Circuit Court of Appeals for the Ninth Circuit, in *Willamette-Hyster Co. v. Pacific Car and Foundry Co.*, 122 F. (2) 492, refused to consider a cited reference which had been overcome by an affidavit under Rule 75, as a valid reference. The Fourth Circuit similarly held in affirming Judge Rose in *Thacher v. Mayor*, 230 F. 1022.

The decision in the case here in issue held the opposite view. In neither decision was evidence presented attacking the affidavit.

**POINT 3.**

**The acceptance of an affidavit under Rule 75 is an adjudication of priority.**

The acceptance of an affidavit under Rule 75 by the Patent Office, antedating a cited reference, is an adjudication on priority as to the cited reference. The oath is decisive as to the fact of antedating. *Deering v. Winona*, cited.

In this case, the issue of priority has been settled by a special tribunal, the Patent Office, entrusted with full power in the premises. *Morgan v. Daniels*, 153 U. S. 120 at 124; *United States v. Bell Telephone*, 167 U. S. 224 at page 267; *United States v. Duell*, 172 U. S. 576; *Steinmetz v. Allen*, 192 U. S. 543.

It is submitted that the Patent Office decision accepting an affidavit under Rule 75 is an adjudication of priority of invention as to the cited application.

**POINT 4.**

**The acceptance of an affidavit under Rule 75 involves an exercise of discretion.**

The issue of a patent upon the acceptance of an affidavit under Rule 75 involves an exercise of discretion by the Patent Office.

The rule requires the applicant to make oath to *facts* showing the completion of his invention in this country before the filing of the application on which the domestic patent issued. In the case in issue, such oath showing completion of the invention within the two-year period which then constituted a statutory bar, together with ad-

ditional evidence, was submitted and accepted. The rule requires consideration of the sufficiency of the facts; and thus requires an exercise of discretion by the Patent Office, more than the mere filing of the affidavit.

### **POINT 5.**

#### **The defendant should controvert the truth of the affidavit.**

When the validity of a patent hinges on a reference which has been overcome by an affidavit under Rule 75, the burden should be on the defendant. *Corona Co. v. Dovan Corp.*, cited.

That this should be the rule is evident if a situation is considered, in which all the evidence has become lost, as in a fire, and all the witnesses have died. In such case, the patent would, on the basis of the decision herein requested reviewed, automatically become invalid in view of the prior cited reference. It is submitted that the burden should rest on the alleged infringer, to overcome the *prima facie* presumption of validity resulting from the acceptance by the Patent Office of the affidavit under Rule 75.

### **POINT 6.**

#### **Infringement exists where the substance of an invention has been appropriated.**

The decision limited the invention to the specific construction disclosed in the patent, without consideration of the substance of the invention. The decision is, there-

fore, contrary to the rule stated by Mr. Justice Curtis in *Winans v. Dinmead*, 56 U. S. 330, p. 343:

“Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention, for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement.”

The United States Supreme Court has uniformly held that infringement is not avoided by a changed construction which appropriates all of the meritorious features of the appropriated invention. *Machine Co. v. Murphy*, 97 U. S. 120, 125; *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 145; *Hobbs v. Beach*, 180 U. S. 383, 398; *Busch v. Jones*, 184 U. S. 598; *Hildreth v. Mastoras*, 257 U. S. 27; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405.

It is submitted that the substance of an invention must be considered when infringement is charged, and that changes from the specific construction illustrated in the patent, which achieve the same result in the same manner, do not avoid infringement.

Respectfully submitted,

NATHANIEL FRUCHT,  
Attorney for Petitioner.



Supreme Court, U. S.

*(12)* FILED

JUN 19 1945

CHARLES ELMORE BROOKLYN  
CLERK

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OCTOBER TERM, 1945

**88**

No. \_\_\_\_\_

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MADGE MESSLER,

*Petitioner,*

*v.*

UNITED STATES RUBBER COMPANY,

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**BRIEF OF RESPONDENT IN OPPOSITION  
TO PETITION FOR CERTIORARI.**

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NEWTON A. BURGESS,

LESTER G. BUDLONG,

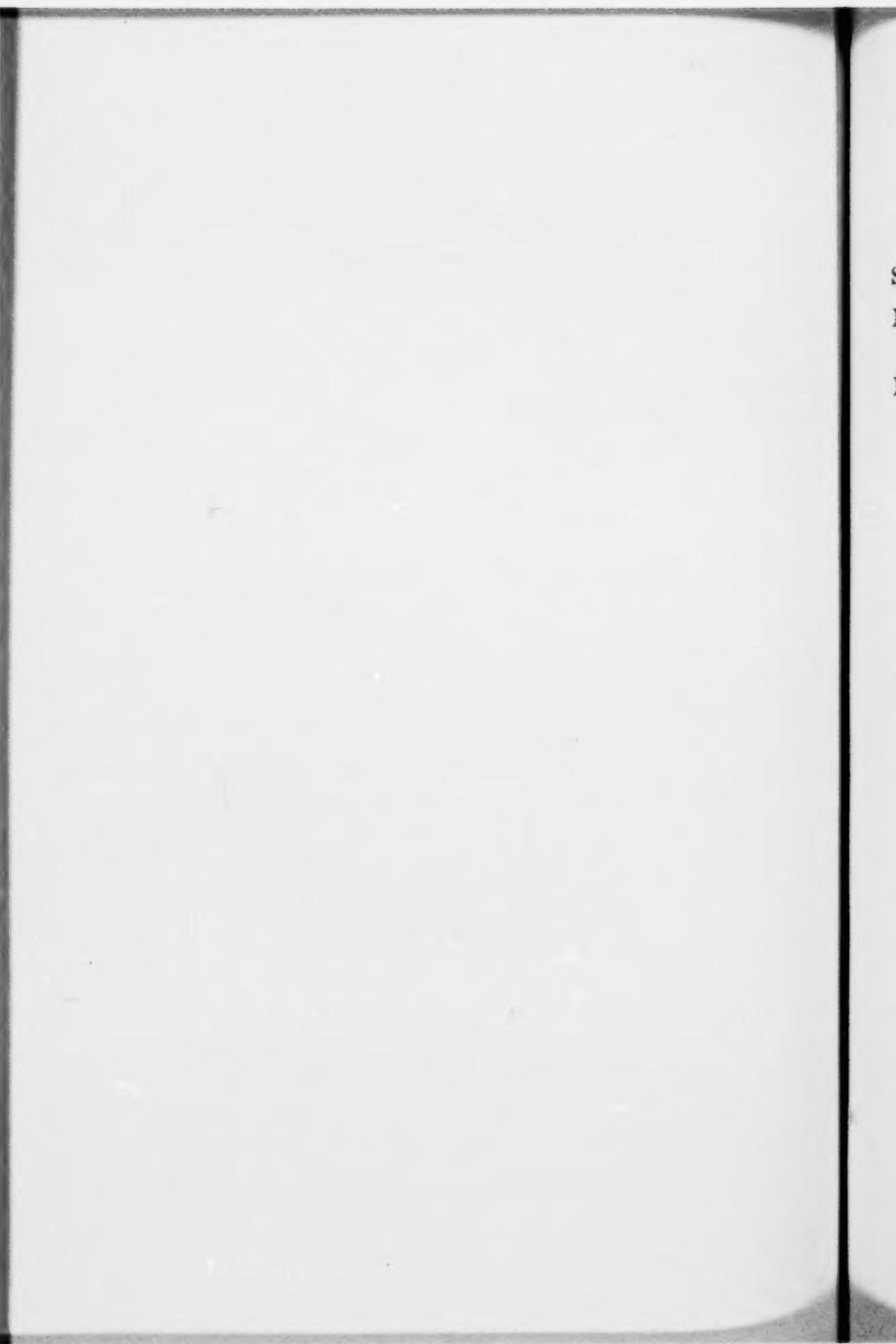
WILLIAM R. EPES,

*Counsel for Respondent.*

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**BRIEF OF RESPONDENT IN OPPOSITION  
TO PETITION FOR CERTIORARI.**

**Statement of the Case.**

This is an ordinary patent case which has gone through the regular channels to the Court of Appeals to decision adverse to the Petitioner. Both lower courts held the Messler patent invalid and non-infringed upon substantially the same grounds. The concurrent holdings of the lower courts strongly indicate that no error has been made. The decision of the District Court was not reported. The decision of the Circuit Court of Appeals is as yet not reported except in 65 U. S. P. Q. 145.

**No Sufficient Grounds Are Alleged for Granting  
the Petition.**

The Petitioner sets forth six grounds for review. The first five of these relate to the holding of invalidity and the sixth to the holding of non-infringement.

The first five points urged by the Petitioner for review are based upon the following portions of the decision of the Court of Appeals:

"The contention that the self-serving declarations of the affidavit filed in the Patent Office five years after Cort's application should be given weight as evidence or should shift the burden of proof to the defendant is to say the least surprising. Under the rule of the Patent Office it served the purpose of securing an issue of the patent in suit in spite of the earlier disclosure by Cort. But the issue under such circumstances in no sense was the equivalent of an adjudication of priority, nor did it involve any exercise of discretion by the Patent Office, for the mere filing of the affidavit required the issue under the rule irrespective of any merits. \* \* \*

The decisions we have referred to fail to persuade us that an ex parte affidavit of an inventor under Rule 75 is evidence which calls upon an allegedly infringing defendant to controvert the truth of the affidavit. \* \* \*

Rule 75 is a rule of procedure established by the United States Patent Office under authority of Section 483 of the Revised Statutes (U. S. C., title 35, Sec. 10). Rule 75 is as follows:

"When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public

use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than one year \* prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year \* prior to the date on which application was filed in this country.”

Affidavits filed under the Rule are in prosecution of patent applications, which is an *ex parte* proceeding. The affiants are not subject to cross examination, as in *inter partes* cases. The affidavits are not even open to public inspection until after the patent has been granted. The public is not bound by such *ex parte* proceedings, but the patentees are. *Keystone Co. v. Phoenix Co.*, 95 U. S. 274, 279. In view of this situation it is clear that such affidavits are nothing more than self-serving declarations, and should not be given weight as evidence to shift the burden of proof to the defendant.

It is also clear from the language of Rule 75 that it sets forth an *ex parte* procedure leading merely to the grant of a patent. This can be in no sense the equivalent of an adjudication of priority.

The question of infringement is one of fact (*Winans v. Denmead* (56 U. S. 545, 551) (15 How. 330); *Coupe v. Royer*, 155 U. S. 565, 575).

Where both the District and Circuit Courts have concurred in their findings on such factual questions, they will not be disturbed by this Court except in cases of clear error. *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405 (1908), at page 416; *Williams Mfg.*

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“\*In the case of applications for patent filed prior to August 5, 1940, this period is two years instead of one year.”

*Co. v. United Shoe Machinery Corporation*, 316 U. S. 364 (1942), at page 367; *Goodyear Tire & Rubber Company v. Ray-O-Vac Co.*, 321 U. S. 275 (1944), at page 278; *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U. S. 471 (1944), at page 473. The petition shows no reviewable error in respect to these factual questions. Therefore, infringement should not be reviewed. Validity then becomes moot, as no controversy would exist between the parties. Such a case is not determinable by Federal Courts under Article 3, Section 2 of the Constitution, as interpreted by the following decisions:

*Aetna Life Insurance Co. v. Haworth*, 84 F. (2d) 695, (Certiorari granted 299 U. S. 536); and *Cover v. Schwartz*, 133 F. (2d) 541, (Certiorari denied 319 U. S. 748).

### **None of Petitioner's Cases Is Apposite.**

None of the cases relied upon by Petitioner supports the ground for which cited, except the case of *Thacher v. Mayor*, 219 Fed. 909 (D. C. Md. affirmed 230 F. 1022), and that case is in direct conflict with *Thacher v. Board of Supervisors*, 235 Fed. 724 (D. C., S. D. Iowa, C. D.). Both the District Court and the Court of Appeals below disregarded the first case and followed the second. It appears also that *Thacher v. Mayor* has been overruled by *Milburn v. Davis*, 270 U. S. 390, as will be shown below.

#### **Cases Under Petitioner's Ground 1:**

The cases of *Deering v. Winona Harvester Works*, 155 U. S. 286, and *Pullman Palace Car Company v. Boston, etc., R. R.*, 44 F. 195 are cited by Petitioner in support of the point that the practice under Rule 75 is well established in the Patent Office and has received the sanction of the courts. There is no dispute as to this.

In the *Deering* case (p. 298) it appears that an English patent was cited as a prior reference against the application for the patent in suit and that the applicant filed an affidavit under Rule 75 which was accepted by the Patent Office to overcome the reference. In the infringement suit the Court did not rely upon the affidavit but upon evidence offered at the trial, such evidence including a model shown by witnesses to have been completed prior to the effective date of the British patent. This case refutes instead of supporting Petitioner.

In the *Pullman* case an affidavit was filed to overcome the prior filing date of a patent to Sessions. It is clear that in the infringement suit the Court did not rely upon the affidavit but upon the testimony of Sessions. The Court (p. 203) stated that:

"The ground taken by the patent-office in finally granting this (Pullman) patent does not appear, but it does appear by this record that Sessions swears that what Pullman said in his affidavit as to his invention was true in point of fact."

This case also refutes instead of supporting Petitioner.

In *Corona v. Dovan Corp.*, 276 U. S. 358, an affidavit under Rule 75 was filed, but the opinion clearly reveals that the affidavit was not relied upon by the Court in the infringement suit. Weiss, the inventor of the patent in suit, introduced extensive testimony and exhibits including laboratory notebooks and other data to establish as early a date as possible (pp. 376, 377). This case is cited in support of the statement that "The reasonable presumption of validity furnished by the grant of a patent on the basis of an affidavit under Rule 75 is not destroyed except by convincing evidence". There is no such statement in the opinion, nor can we find anything like it. In respect to "The reasonable presumption of validity furnished by the grant

of a patent" the Court said (p. 374) that it had not been shown that the patent in suit was obtained through false evidence or reckless statements made in affidavits filed under Rule 75.

The cases of *Miller v. Brass Company* and *Alvord v. Smith et al.* (p. 6 of Petitioner's brief) were cited in support of the point that when a patent does not claim an invention, it is either not the patentee's invention, or if it is, he thereby dedicates it to the public. That point is immaterial to any issue involved here. The present case comes squarely under the subsequently decided case of *Milburn v. Davis*, 270 U. S. 390.

#### ***Cases Under Petitioner's Ground 2:***

The cases *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F. (2d) 492, and *Thacher v. Mayor*, 230 F. 1022 are cited as being in conflict with the decision of the Court below on the point that a patent which was overcome by an affidavit under Rule 75 is a valid reference.

In the *Willamette* case the suit was on a patent, in the course of prosecution of which an affidavit under Rule 75 was filed. It appears from the decision (p. 497) that the Court paid no attention to the affidavit under Rule 75, but on the other hand held the patent in suit invalid in view of a publication having an effective date more than two years prior to the filing date of the patent in suit. The foregoing shows that this decision of the 9th Circuit is not in conflict with the Court of Appeals in this case.

The case of *Thacher v. Mayor* appears to be in direct conflict with the decision below in this case. The decision in the *Thacher* case is unsound on elementary principles of law. It is so clearly out of line that it should be disregarded. Furthermore, the *Thacher* case was affirmed by

the Fourth Circuit Court of Appeals on February 2, 1916, which was prior to the decision in the *Milburn* case on March 8, 1926. Prior to the latter date, as stated in the *Milburn* decision (p. 399), there was a conflict in the Circuit Courts as to whether or not a patent disclosing, but not claiming, an invention and issuing upon an application co-pending with a later filed application was a reference against a patent in suit claiming the invention and issuing upon a later filed application. The *Milburn* case decided that the patent which issued on the earlier filed co-pending application was a reference. In view of this decision, the only way the patent in suit could be valid was by carrying the patentee's date of invention back of the earlier filing date of the reference patent. If this had been the law at the time *Thacker v. Mayor* was decided, obviously the Court would not have held that the affidavit under Rule 75 was alone sufficient to carry back the date of invention.

As to whether or not an affidavit under Rule 75 is sufficient alone to carry back the date of invention when not supported by other evidence, there is no conflict in the cases since *Milburn v. Davis*.

#### ***Cases Under Petitioner's Ground 3:***

It is well known that the Patent Office makes no attempt to inquire into the truth or falsity of an affidavit under Rule 75, and therefore its decision on this point is in no sense an adjudication of priority. As already explained, the Court did not accept the affidavit under Rule 75 without supporting evidence to carry back the date of invention in the *Deering* case. The other cases cited under this Ground have no bearing on the issues involved.

#### ***Petitioner's Ground 4:***

No cases are cited by Petitioner in support of Ground 4. As previously explained, once the applicant has complied

with the provisions of Rule 75, the affidavit is accepted without further exercise of discretion on the part of the Patent Office.

***Cases Under Petitioner's Ground 5:***

Petitioner again cites the *Corona* case under her Ground 5 in support of the proposition that when the validity of a patent hinges on a reference which has been overcome by an affidavit under Rule 75, the burden should be on the defendant. As previously pointed out herein, in the *Corona* case the patentee of the patent in suit did not rely upon the affidavit under Rule 75 but on the other hand called witnesses who submitted additional data to carry back the date of invention. So far as the opinion reveals, the affidavits were not relied upon to carry back the date of invention without the support of the additional evidence. There is nothing to show that the burden of proof shifted before the additional evidence was introduced.

***Cases Under Petitioner's Ground 6:***

The Petitioner has cited a number of cases in support of Ground 6 relating to the matter of infringement. There does not appear to be any doubt as to the proper interpretation of the scope of the claims of the patent in suit by the lower courts. It therefore appears that the decisions cited by the Petitioner are inapplicable, and as this question is one of fact, the concurrent findings by the lower courts should not be disturbed for reasons already pointed out (*supra*, p. 3).

***Conclusion.***

The Petitioner has not shown that this case involves any matter of important public interest, or that there is any conflict of opinion on the principles involved between dif-

ferent Circuit Courts of Appeal since the decision in the *Milburn* case, or that the decision of the Second Circuit Court of Appeals in this case is clearly erroneous. The factual question of infringement is decisive in the case and renders it wholly unnecessary for this Court to decide any other issues even if such issues were present in the case. For these reasons the petition should be denied.

Respectfully submitted,

NEWTON A. BURGESS,  
LESTER G. BUDLONG,  
WILLIAM R. EPES,  
*Counsel for Respondent.*